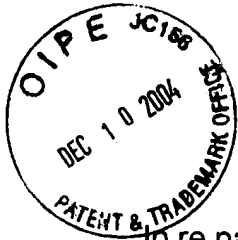


AF 740



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:) Date: December 7, 2004
Ronald P. Sansone, et al.) Attorney Docket No.: F-183
Serial No.: 09/818,792) Customer No.: 00919
Filed: March 27, 2001) Group Art Unit: 3629
Confirmation No.: 9874) Examiner: Richard Sukyoon Woo
Title: **RECIPIENT ELECTED MESSAGING SERVICES**

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

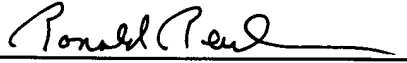
Transmitted herewith in **triplicate** is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on October 12, 2004.

Pursuant to 37 CFR 1.17(c), the fee for filing the Appeal Brief is \$340.00. Please charge Deposit Account No. **16-1885** in the amount of \$340.00 to cover the above fees.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

A duplicate copy of this transmittal is enclosed for use in charging the Deposit Account.

Respectfully submitted,



Ronald Reichman
Reg. No. 26,796
Attorney of Record
Telephone (203) 924-3854

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000

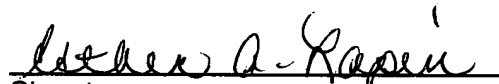
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on December 7, 2004
Date of Deposit

Esther A. Lapin
Name of Rep.


Signature

December 7, 2004
Date



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Ronald P. Sansone, et al

Serial No.: 09/818,792

Filed: March 27, 2001

Confirmation No.: 9874

) Attorney Docket No.: F-183

) Group Art Unit: 3629

) Examiner: Richard Sukyoon Woo

) Date: 7 December 2004

) Customer No.: 00919

Title: RECIPIENT ELECTED MESSAGING SERVICES

APPELLANTS' BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This brief is in furtherance of the Notice of Appeal filed in this case on October 12, 2004.

This brief is transmitted in triplicate.

12/10/2004 ZJU HAR1 00000046 161885 09818792

01 FC:1402 340.00 DA

TABLE OF CONTENTS

This brief contains these items under the following headings and in the order set forth below:

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENTS
- VII PRAYER FOR RELIEF
- VIII. CLAIMS APPENDIX

I. REAL PARTY IN INTEREST

Pitney Bowes Inc. is the real party in interest by way of assignment from the Appellant.

II. RELATED APPEALS AND INTERFERENCES

An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 09/818,480 entitled " Recipient Elected Messaging Services That Is Transported In Trays Or Tubs" may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

- A.) Claims 1-35 are in the application.
- B.) Claims 1-35 are rejected.
- C.) Claims 1-35 are on appeal.

IV. STATUS OF AMENDMENTS

An Amendment subsequent to the July 13, 2004, Final Rejection was filed on August 25, 2004. This Amendment was not entered.

V. SUMMARY OF INVENTION

A. BACKGROUND

Ever since the numeric codification of streets and buildings received general acceptance, an individual's name and household postal address have been linked. The sender of a letter or package would deliver a letter or package to the post that had the correct recipient postal address, and the post would deliver the letter or package to the numeric street address of the recipient of the letter or package. A correct recipient postal address for the delivery of the letter or package to the recipient included: the name of the recipient; the street address of the recipient; the city and state of the recipient; and the zip code of the recipient. Thus, the correct recipient postal address is usually the actual location of the recipient.

Typically, it takes the post three to five days to deliver letters and/or packages to a recipient. Sometimes, recipients of letters and packages like to know what letters and packages they are going to receive before they receive them. For instance, if someone is going on a trip, they may want to receive their bills, e.g., credit card, electric, gas, oil, hospital, doctor, etc. before they leave on the trip so that they may pay the bills before a finance charge for late payment of the bill is applied to their account. Someone may also want to receive a package before they go on a trip so that they may take the contents of the package on the trip. The recipient may also want to delay delivery of a particular letter or package until they return from their trip. The reason for the foregoing may be that the recipient does not want to retrieve the letter or package at the post office or have the letter or package waiting at a vacant house..

B. APPELLANTS' CLAIMED INVENTION

1. Claim 1 relates to a method that enables a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail delivered. More particularly, claim 1 includes the following steps: depositing by a sender with the carrier mail containing the recipient's name and physical address and a sender's name and address; capturing by the carrier the name and physical address of the recipient and the sender in the form of an image; transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; translating by a data center the name and physical address of the recipient into an e-mail address; notifying by the data center to the recipient of the expected delivery of the deposited mail and indicating the selected alphanumeric of the translated image; notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered; notifying by the data center to the carrier of the manner in which the recipient wants the mail delivered; and delivering mail by the carrier to the recipient in the manner specified by the recipient to the carrier.

Appellants' invention is a method that enables a receiver or receiver's agent (hereinafter "recipient") to obtain notification of the letters, flats and/or packages (mail) that the recipient is going to receive prior to the delivery of the mail. The recipient is then able to inform a post or courier e.g., Federal Express®, Airborne,® United Parcel Service®, DHL®, etc. of the manner in which the recipient would like the mail delivered.

Appellants' claimed invention is shown in Fig. 2 and described in line 12 of page 5 to line 9 of page 10 of Appellants' Patent Application. A copy Fig.2 appears next to this page.

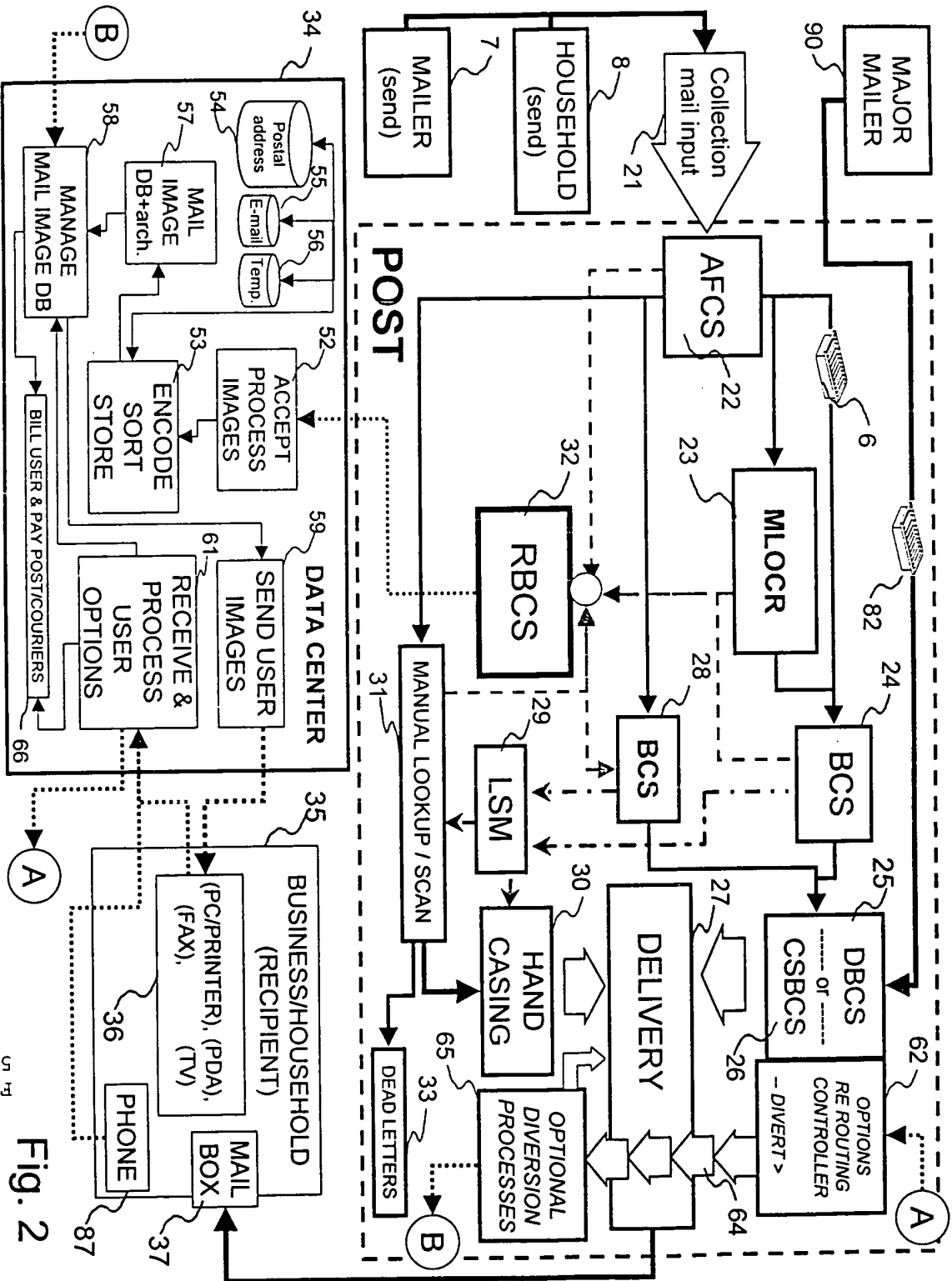


Fig. 2

Fig. 2 is a drawing showing how this invention may be used by a post in the processing of letter mail. Letter mail that is deposited in trays 6 and delivered to the post is read by multiple optical character reader ("MLOCR") 23. Collection letter mail may be: metered letter mail that is produced at a mailer site 7 or a sender household 8 by a postage meter or a personal computer meter; stamped mail; or permit mail. Collection letter mail is placed in collection mail input 21, e.g., mail boxes or delivered to the United States Postal Service unsorted. Collection letter mail is sent to advanced facer canceller ("AFCS") 22. AFCS 22 first faces the letter mail. Then AFCS 22 electronically identifies and separates prebarcoded mail, handwritten addresses and machine-imprinted address pieces for faster processing through automation. Letter mail that AFCS 22 determines is optical character readable is sent to MLOCR 23. MLOCR 23 reads the entire address on the letter mail: sprays a bar code on the mail; and then sorts the mail. Letter mail that is able to be scanned and sorted by MLOCR 23 is sent to bar code sorter/code printer ("BCS") 24. Letter mail that the mailer has prebarcoded and contains a facing identification mark is sent to a printer contained in BCS 24.

Trayed mail 82 (mail in which the sender is entitled to discounts) that is produced at a major mailer site 90 (Fig. 5) is sent to a delivery bar code sorter/code printer ("DBCS") 25 or a carrier sequence bar code sorter/code printer ("CSBCS") 26. Sorters 25 and 26 sort the letter mail in the order that the mail is going to be delivered by postal carrier 27. Letter mail that AFCS 22 determines is not optical character readable is sent to bar code sorter/code printer ("BCS") 28. Letter mail that AFCS 22 determines is not optical character readable is sent to bar code sorter/code printer ("BCS") 28. Letter mail that AFCS 22 obtains electronic images from and letter mail that MLOCR 23 obtains

electronic images from transfers the electronic images to RBCS 32. RBCS 32 matches the look up zip code for the letter mailpieces from AFCS 22 and merges them. RBCS 32 electronically transmits the bar code information to sorter 28 where the bar code information is sprayed on the mailpieces. Letter mail that is able to be scanned and sorted by sorters 24 and 28 is sent to DBCS 25. Sorters 25 and 26 sort the letter mail in the order that the mail is going to be delivered by postal carrier 27, or hold the mail for recipient diversion for a specified period of time in divert mail options rerouting controller 62.

Letter mail that can not be scanned and sorted by sorters 24 and 28 is sent to LSM 29. Letter mail that can be sorted by LSM 29 is sent to hand casing 30. Hand casing 30 is the process in which the postal carrier sorts the letter mail in the order that the letter mail is going to be delivered by postal carrier 27. Letter mail that can not be sorted by LSM 29 is sent to manual process 31. Manual lookup/scan 31 attempts to classify the previously rejected letter mailpiece to redirect the mailpiece; declare the mailpiece dead; or manually re-code the mailpiece for redelivery. Then the letter mailpieces that have not been processed in manual lookup, scan and sortation process 31 are sent to dead letters 33. In process 31, an operator may determine the address of the recipient and produce a label to be placed on the letter mail. Then the letter mail would go to postal hand casing 30 where the mail is sorted in the order that the mail is going to be delivered by postal carrier 27.

Letter mail that can not be faced and cancelled by AFCS 22 is sent to manual lookup/scan 31. Manual lookup/scan 31 attempts to classify the previously rejected letter mailpiece to redirect the mailpiece; declare the mailpiece dead; or manually re-

code the mailpiece for redelivery. Then the letter mail that manual process 31 is able to classify is sent to postal carrier hand casing 30 before it is delivered by postal carrier 27.

RBCS 32 electronically transmits the bar code information that represents the destination of the letter mailpiece and the party to whom the mailpiece is to be delivered and the image of the face of the mailpiece to data center 34. The aforementioned scanners scan all of the information appearing on the face of the letter mail, e.g., the sender's name and address 12 (Fig. 1A), the recipient's name and address 13 and postal indicia 14. The scanned information is transferred to accept process images 52. Then the information is sent to encode, sort, store 53. At this point, the recipient's physical address is verified by checking postal address data base 54, and the recipient's e-mail address is determined from e-mail data base 55. Temporary data base 56 is then searched to determine whether the recipient has left any forwarding addresses. Encode, sort, store 53 then encodes and sorts the information obtained from data bases 54, 55 and 56.

The aforementioned encoded and sorted information is stored in mail image data base + archive 57. Then the mail image information is sent to manage mail image db 58 where the various options and the costs associated therewith that the recipient may have for delivering the information contained in the letter mail are determined. Then the mail images and options that the recipient has for receiving the letter mail are sent to send user images 59, where the information appearing on the face of the letter mail in alphanumeric and graphic form and the options in alphanumeric and graphic form, the recipient has for receiving the letter mail is transmitted to receiving device 36 (personal computer, television, facsimile machine, personal data assistant, etc.), which is located

at the recipient's business or household 35. Device 36 also may be a mobile device located with the recipient for use outside the recipient's business or household 35. The options that the recipient has for diverting the letter mail are described in the description of Fig. 4.

The recipient may use device 36 (personal computer, facsimile machine, personal data assistant, etc.) located at the recipient's business or household 35 to inform, receive and process user options 61, located at data center 34, of the manner in which the letter mail should be delivered. The recipient may also use a touch tone and/or voice telephone 87 to inform receive & process user options 61 of the manner in which the recipient would like the letter mail displayed on the receiving device 36, e.g., television delivered. For instance, the recipient may want the letter mail physically delivered to the recipient's house faster or slower, or the letter mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the post open the letter mail and have the post e-mail or fax the contents of the letter mail to the recipient and/or parties designated by the recipient.

At this juncture, the recipient may inform options 61 via a device 36 of the manner in which the recipient would like the letter mail processed. Options 61 will then inform the recipient via device 36 of the cost to the recipient to process the letter mail in the manner selected by the recipient. The recipient may then inform the post to deliver the letter mail in the manner selected by the recipient. The recipient's selected manner of letter mail processing is forwarded to options rerouting controller 62. If the post specified time to deliver the letter mail has not been reached, the letter mail is sent to

recipient options 64 and delivered in the manner selected by the recipient in optional diversion processes 65. Then optional diversion processes 65 informs manage mail image data base 58 to archive the image and also to notify bill user and pay post couriers 66 to bill the recipient and pay the post. At this point, the next letter mail image is ready to be processed.

The letter mail may then be delivered to the recipient at mail box 37 at a faster or slower rate than that selected by the sender; held by the post for a specified amount of time and then delivered to an address specified by the recipient; opened, and the contents of the letter mail faxed to recipient-selected fax numbers; opened, and the contents of the letter mail faxed to recipient-selected fax numbers, and then the letter mail may be delivered to the physical address specified by the recipient; opened, and the contents of the letter mail e-mailed to recipient-selected e-mail addresses; or opened, and the contents of the letter mail e-mailed to recipient-selected e-mail addresses, and then the letter mail may be delivered to the physical address specified by the recipient. The recipient may also have instructed the post to return the mail to the sender, to destroy the mail, or to recycle the paper in the letter mail. Receive & process user options 61 will also send the cost of the recipient selected manner of delivery to bill user & pay post/couriers 66 so that data center 34 may inform the post to debit the recipients account or send a bill to the recipient.

2A. Claim 4 depends on claim 1, and relates to the recipient's notification of the carrier to open the mail.

2B. Claim 5 depends on claim 4, which depends on claim 1. Claim 6 depends on claim 4, which depends on claim 1. Claims 5 and 6 relate to informing the carrier to

extract the contents of the mailpiece to one or more specified e-mail addresses; and mailing by e-mail the information included in contents of the mailpiece to the specified e-mail addresses.

2C. Claims 7 –10 depend on claim 4 and relate to the recipient's notification of the carrier to open the mail and the carrier sending the recipient information contained in the mailing.

The above features of Appellants' claimed invention is described on lines 1 – 6 of page 9 of Appellants' Patent Application, which read as follows. "For instance, the recipient may want the letter mail physically delivered to the recipient's house faster or slower, or the letter mail physically redirected to the recipient's temporary address, or physically delivered to the recipient's agent, or physically delivered to the recipient's attorney, or physically returned to the mailer, or have the post open the letter mail and have the post e-mail or fax the contents of the letter mail to the recipient and/or parties designated by the recipient.

3. Claims 11 – 16 depend on claim 1 which relate to charging the recipient for the request service. The above features of Appellants' claimed invention is described on lines 7 – 18 of page 9 of Appellants' Patent Application, which read as follows.

"At this juncture, the recipient may inform options 61 via a device 36 of the manner in which the recipient would like the letter mail processed. Options 61 will then inform the recipient via device 36 of the cost to the recipient to process the letter mail in the manner selected by the recipient. The recipient may then inform the post to deliver the letter mail in the manner selected by the recipient. The recipient's selected manner of letter mail processing is forwarded to options rerouting controller 62. If the post specified time to deliver the letter mail has not been reached, the letter mail is sent to recipient options 64 and delivered in the manner selected by the recipient in optional diversion processes 65. Then optional diversion processes 65 informs manage mail image data base 58 to

archive the image and also to notify bill user and pay post couriers 66 to bill the recipient and pay the post. At this point, the next letter mail image is ready to be processed.”

4. Claims 17 – 28 depend on claim 1 which relate to the recipient notifying the carrier in the handling of the mail. The above features of Appellants' claimed invention, is described on line 19 of page 9 to line 9 of page 10 of Appellants' Patent Application, which read as follows.

“The letter mail may then be delivered to the recipient at mail box 37 at a faster or slower rate than that selected by the sender; held by the post for a specified amount of time and then delivered to an address specified by the recipient; opened, and the contents of the letter mail faxed to recipient-selected fax numbers; opened, and the contents of the letter mail faxed to recipient-selected fax numbers, and then the letter mail may be delivered to the physical address specified by the recipient; opened, and the contents of the letter mail e-mailed to recipient-selected e-mail addresses; or opened, and the contents of the letter mail e-mailed to recipient-selected e-mail addresses, and then the letter mail may be delivered to the physical address specified by the recipient. The recipient may also have instructed the post to return the mail to the sender, to destroy the mail, or to recycle the paper in the letter mail. Receive & process user options 61 will also send the cost of the recipient selected manner of delivery to bill user & pay post/couriers 66 so that data center 34 may inform the post to debit the recipients account or send a bill to the recipient.”

5. Claims 29 – 35 depend on claim 1 which relate to placing a graphic on the mail. The above features of Appellants' claimed invention, is described on line 17 of page 4 to line 11 of page 5 of Appellants' Patent Application, which read as follows.

“Referring now to the drawings in detail and more particularly to Fig. 1A, the reference character 11 represents a mailpiece that has a sender address field 12, a recipient address field 13 and a postal indicia 14.

Fig. 1B is a drawing of a permit mailpiece. Mailpiece 15 has a sender address field 16, a recipient address field 17 and a permit 18.

Fig. 1C is a drawing of a stamped mailpiece. Mailpiece 19 has a

sender address field 20, a recipient address field 9 and a stamp 10. Fig. 1D is a drawing of a flat or package that is going to be delivered by a carrier. Package 40 has a label 39 affixed thereto. Label 39 has a sender address field 41, a recipient address field 42 and may have other sender information, e.g., the sender's phone number 44. Indicia 43 is affixed to label 39. Indicia 43 may be a postal indicia or courier symbology.

Figs. 1A-1D show various methods of evidence for the payment of postage. It will be obvious to one skilled in the art that additional methods of evidence for the payment of postage exist."

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether or not claims 1-3, 12, 13, 17 – 19, 21, 25 and 28 - 35 are patentable under 35 USC §103(a) as being over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

B. Whether or not claims 4 – 10, 14 – 16, 20, 22 – 24 and 26 –27 are patentable under 35 USC §103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

VII. ARGUMENTS

A. Claims 1-3, 12, 13, 17 – 19, 21, 25 and 28 – 35 have been rejected by the Examiner under 35 U.S.C. 103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

Smith discloses the following in paragraphs [0053] and [0054] of Patent Application 0095306:

"[0053] If the user continues the session, the Postport system retains the relevant postal transaction session information in a manner that is linked to the user's assigned user ID, as discussed below. When the user later logs on to the Postport system from, for example, a terminal 188 at the postal station 176 using the assigned user ID, the system transfers the session to the terminal. The user then continues to enter and/or edit the mailing address

and postage information and/or print the labels and the postage before ending the session.

[0054] The session transfer may be facilitated by assigning to a given user a coded physical identification token, such as a key fob **200** with a User ID included as a machine-readable barcode **201** (**FIG. 11**). The user presents his or her physical identification token to a scanner that is connected to the system through, for example, the work station node **180**. The system then prompts the user to supply his or her password and, after verification of the password, the system transfers the linked messages and thus the session to the terminal then in use. As discussed in more detail below, the system may also transfer the linked messages to the various other terminals in the same postal station, such that the user can readily transfer the session to another terminal that is connected to a printer, a postage meter, and so forth, by logging on using the assigned user ID. The user may thus take fully advantage of the Postport system's virtual post office services, even if he or she does not have the appropriate hardware and/or software to print the labels and postage.

Smith discloses the following in paragraph **[0033]** of Patent Application 0042808:

“[0033] The Postal Server may comprise a single server, or be one of a plurality of such servers, preferably interconnected for sharing data. Associated with each server is a database **171** on which the identify and other pertinent data such as physical (i.e. street) address, email address, unique identifier, telephone number, mail delivery preferences and other such data with respect to each of its customers is stored. The Postal Service itself may use access this database [sic] to obtain the current address of a customer for delivery of the physical mail in the case of mail that is found to have been misdirected or returned for insufficient or incorrect address. It may also access this database in order to ascertain the correct current address of a customer in the first instance. For example, third parties wishing to send mail to then customer may simply address the mail with the customer's unique Postal Identifier if one has been provided to the third party, or by means of the customer's email address, or by some other identifier or combination of identifiers corresponding to data associated with that customer in the database **171** and which uniquely identifies that customer. The Postal Service can then retrieve the physical address of that customer for delivery of the physical item to it, and may additionally

provide notification to be customer concerning the item being sent as described in detail above. Alternatively, the Postal Service may, under suitable conditions, provide access to its database directly to the third party, which may then retrieve the necessary data for sending physical mail to the customer."

Higgins discloses the following in column 4, line 34 to column 5, line 11:

"In determining the correct zip code it is important to note that the quality of the address interpretation depends on the success of the previous steps. Without the correct ABL, good segmentation and reasonable character recognition, there is little hope of finding the correct zip.

In order for the correct zip to be found, the following conditions have to be met. The correct candidate ABL has to be used. The number of characters in the word containing the zip has to clearly indicate that this word contains the zip code. That is, segmentation must recognize the word breaks around the zip code, which is quite difficult for hand images due to inconsistencies in handwriting. The characters have to be segmented correctly. Errors in character segmentation such as splitting a character into two separate characters or combining two characters as one, preclude the possibility of good character recognition and, hence, address interpretation. Character recognition must produce the correct character. The confidence of the correct characters have to be good. This is not as important as having the correct character recognized, but it does allow more decisions on zip codes to be finalized.

An example of an image **64** passed through this conventional process of address block location segmentations, character recognition and address interpretation indicated by reference number **65** is shown in Fig. **5**. In this illustrative example, a case where the address interpretation process could not make a determination due to the inaccurately recognized digit (13821 versus 13827).

Since 13821 is not a valid zip code, as can be verified with a database search, a bar code will not be assigned and so manual processing is required. It will be shown, hereinafter, how adaptive signal processing, in accordance with the present invention, was successfully applied to this problem.

In this example, the zip code has been recognized incorrectly and so the database search does not yield an exact match. Rather than assigning a potentially incorrect bar code, the letter is not assigned, i.e., no bar code is printed on the front of the envelope.

While the conventional OCR process treats each image independently, adaptive OCR, in accordance with the present invention, attempts to exploit any statistical characteristics of the mail stream. If one could gather real-time statistics on the mail stream, it seems plausible that this data could be exploited to achieve higher recognition rates.

Neither Smith nor Higgins, taken separately or together, discloses or anticipates the steps of claim 1, and those claims dependent thereon, namely, of capturing by the carrier the name and physical address of the recipient and the sender in the form of an image; transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumerics; and notifying by the data center to the recipient of the expected delivery of the deposited mail and indicating the selected alphanumerics of the translated image.

Higgins discloses a method for the cursive address recognition of mail pieces. In Smith, the recipient is not notified of the expected delivery of deposited mail while indicating the selected alphanumerics of the translated image. Smith also requires that the (sender) user print a user ID included as a machine-readable barcode 201 so as to capture the identity of each mailpiece during the inbound postal tracking process, to enable accurate data message linkage prior to the physical delivery of the mail piece to the (recipient) user. Furthermore, Smith requires this same ID code be associated (added) to any other postal data object (message, etc.) so that it can be late associated (linked) at the mail piece recipient's computer display. Smith does not resolve how he can produce the accurate merging of more than one such data objects for a sender that

submits more than one mail piece with the same personal ID code into the postal system on the same day.

Appellants do not claim a method in which a sender printed personal ID code is added to each mailpiece, and the ID code is captured by the post. Appellants claim a method in which the carrier captures the name and physical address of the recipient and sender in the form of an image and the translation by a data center of the name and physical address of the recipient into an e-mail address.

Notwithstanding the foregoing, in rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *in re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *in re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *in re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *in re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *in re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

B. Claims 4 – 10, 14 – 16, 20, 22 – 24 and 26 –27 have been rejected by the Examiner under 35 U.S.C. 103(a) over Smith, et al. (U.S. 2002/0095306A1 or U.S. 2002/0042808A1) in view of Higgins, et al. (U.S. 5,754,671).

The Examiner indicated in pages 6 and 7 of the July 13, 2004, Final Rejection that:

“However, the modified Smith et al. does not specifically disclose the method including the limitations in Claims 4, 7-10,14-16, 20, 22-24 and 26-27 (opening the mail, sending the information contents to PDA, using facsimile, how to charge, recycling the mail, telephoning, and notifying via television.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to arrange to open the mail, sending the information contents to PDA, notify via a facsimile, telephone or television, charge the recipient for the service and recycle the mail because Applicant has not disclosed that the above claimed limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified method of Smith et al. because one of ordinary skill in the art may adopt other notification manners and incorporate them into the modified notification system of Smith et al.

Therefore, it would have been an obvious matter of design choice to further modify the modified invention of Smith et al. in view of Higgins, et al. so as to obtain the invention as specified in claims 4, 7-10, 14-16, 20, 22-24 and 26-27.”

Claims 4 – 10, 14 – 16, 20, 22 – 24 and 26 –27 depend on claim 1 or claims that depend on claim 1. In addition to the arguments made in above Section A, the Examiner has not cited any art to indicate why it would be obvious to send the contents of the mailpiece via different specified channels in the environment of claim 1. T

The limitations of the above claims provide an advantage to a sender of physical mail in that the sender is able to allow the recipient to receive the contents of the

physical mail in the media of the recipient's choice. Thus, the recipient is more likely to respond to the message contained in the mailpiece. This is particularly important in the case of advertising mail where the recipient will be more likely to purchase something. The limitations of the above claims also provide an advantage to a recipient of physical mail in that the recipient is able to receive the information in the media of their choice.

VII PRAYER FOR RELIEF

Appellants respectfully submit that appealed claims 1 – 35 in this application are patentable. It is requested that the Board of Appeal overrule the Examiner and direct allowance of the rejected claims.

Respectfully submitted,



Ronald Reichman
Reg. No. 26,796
Attorney of Record
Telephone (203) 924-3854

PITNEY BOWES INC.
Intellectual Property and Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484-8000

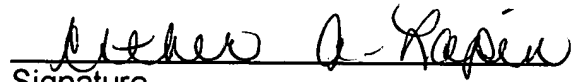
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States
Postal Service as first class mail in an envelope addressed to:

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on December 7, 2004
Date of Deposit

Esther A. Lapin
Name of Rep.


Signature

December 7, 2004
Date

VIII. Claims Appendix A

1. A method that enables a recipient to inform a carrier of the manner in which the recipient wants some or all of their mail delivered, said method comprises the steps of:

depositing by a sender with the carrier mail containing the recipient's name and physical address and a sender's name and address;

capturing by the carrier the name and physical address of the recipient and the sender in the form of an image;

transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumerics;

translating by a data center the name and physical address of the recipient into an e-mail address;

notifying by the data center to the recipient of the expected delivery of the deposited mail and indicating the selected alphanumerics of the translated image;

notifying by the recipient to the data center of the manner in which the recipient wants some or all of their mail delivered;

notifying by the data center to the carrier of the manner in which the recipient wants the mail delivered; and

delivering mail by the carrier to the recipient in the manner specified by the recipient to the carrier.

2. The method claimed in claim 1, wherein the recipient notifies the carrier to deliver the mail to a specified name and address.

3. The method claimed in claim 1, wherein the recipient notifies the carrier to return the mail to the sender.

4. The method claimed in claim 1, wherein the recipient notifies the carrier to open the mail.

5. The method claimed in claim 4, further including the steps of:
informing the carrier to extract the contents of the mailpiece to the recipient; and
mailing by e-mail the information included in contents of the mailpiece to the recipient.

6. The method claimed in claim 4, further including the steps of:
informing the carrier to extract the contents of the mailpiece to one or more specified e-mail addresses; and
mailing by e-mail the information included in contents of the mailpiece to the specified e-mail addresses.

7. The method claimed in claim 4, further including the steps of:
informing the carrier to extract the contents of the mailpiece to the recipient; and
sending the information contents of the mailpiece to the recipient's personal data assistant.

8. The method claimed in claim 4, further including the steps of:

 informing the carrier to extract the contents of the mailpiece to the recipient; and

 reading the information contents of the mailpiece to the recipient via telephone.

9. The method claimed in claim 4, further including the steps of:

 informing the carrier to send by facsimile the contents of the mailpiece to the
recipient; and

 mailing by facsimile the contents of the mailpiece to the recipient.

10. The method claimed in claim 4, further including the steps of:

 informing the carrier to facsimile the contents of the mailpiece to one or more
specified facsimile numbers; and

 sending by facsimile the contents of the mailpiece to the specified facsimile
numbers.

11. The method claimed in claim 1, wherein the recipient notifies the carrier to
deliver the mail to the recipient at a different address.

12. The method claimed in claim 1, wherein the recipient notifies the carrier to
deliver the mail to the recipient by a slower delivery method than that paid for by
the sender.

13. The method claimed in claim 1, wherein the recipient notifies the carrier to deliver the mail to the recipient by a faster delivery method than that paid for by the sender.
14. The method claimed in claim 1, further including the step of:
charging the recipient for receiving notification of the availability of the deposited mail.
15. The method claimed in claim 1, further including the step of:
charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.
16. The method claimed in claim 1, further including the step of:
charging the recipient for receiving notification of the availability of the deposited mail; and
charging the recipient for delivering mail to the recipient in the manner specified by the recipient to the carrier.
17. The method claimed in claim 1, further including the step of:
informing the sender of the delivery of the mail.
18. The method claimed in claim 1, wherein the recipient notifies the carrier to hold the mail for a specified period of time.

19. The method claimed in claim 1, wherein the recipient notifies the carrier to destroy the mail.

20. The method claimed in claim 1, wherein the recipient notifies the carrier to recycle the material comprising the mail.

21. The method claimed in claim 1, wherein the recipient is notified via e-mail of the availability of the deposited mail.

22. The method claimed in claim 1, wherein the recipient is notified via telephone of the availability of the deposited mail.

23. The method claimed in claim 1, wherein the recipient is notified via facsimile of the availability of the deposited mail.

24. The method claimed in claim 1, wherein the recipient is notified via television of the availability of the deposited mail.

25. The method claimed in claim 1, wherein the carrier is notified via e-mail of the manner in which the recipient wants the mail delivered.

26. The method claimed in claim 1, wherein the carrier is notified via facsimile of the manner in which the recipient wants the mail delivered.

27. The method claimed in claim 1, wherein the carrier is notified via telephone of the manner in which the recipient wants the mail delivered.

28. The method claimed in claim 1, wherein the recipient notifies a data center who notifies the carrier of the manner in which the recipient wants the mail delivered.

29. The method claimed in claim 1, wherein the mail deposited with the carrier contains a graphic.

30. The method claimed in claim 29, wherein the graphic is a stamp.

31. The method claimed in claim 29, wherein the graphic is a postal indicia.

32. The method claimed in claim 29, wherein the graphic is a permit.

33. The method claimed in claim 29, wherein the graphic is carrier symbology.

34. The method claimed in claim 29, wherein the graphic is captured and translated.

35. The method claimed in claim 29, wherein the graphic is stored.